

REMARKS

Claim 39 has been amended to delete embodiments wherein X¹ is SO₂. This amendment is made to expedite prosecution, and clearly places the claims in a better position for allowance and appeal. The amendment does not raise new issues; indeed it disposes of one of the issues raised by the Examiner – namely those compounds disclosed in CA 131:67650. The amendment was not sooner made because it was not possible to verify the date of publication of this abstract prior to the previous response. No new matter is added, the issues are simplified, and therefore the entry of the amendment, though made after final, is respectfully requested.

Applicants appreciate the acknowledgement that the rejection for obviousness type-double patenting made in the previous office action has been resolved.

Applicants also appreciate the apparent withdrawal of the rejections made over CHEMCATS 2002:1367700, CA 132:347492, and CA 135:313624.

Only the rejection over CA 131:67650 was maintained; CA 139:117268 is newly cited.

Applicants note that claims 39-53 and 56-78 are pending; claims 54 and 55 were cancelled in the previous response.

“Substitute Specification”

The Office requests verification of the accuracy of the specification filed along with the previous response, which was included to replace that filed originally. A Verified Statement that the specification filed with the previous response is identical to the specification of U.S. Serial No. 09/316,761 filed 21 May 1999 is enclosed. As explained in the previous response, the specification of Serial No. 09/128,137 was filed in error. The Preliminary Amendment filed along with the original application herein states that the application is a divisional application of U.S.

Serial No. 09/316,761 filed 21 May 1999; the contents of this application, as well as others from which priority was claimed were incorporated by reference. Thus, the specification as filed does not contain new matter as it is an accurate copy of the specification of which the present case is a divisional, and which specification was incorporated by reference.

It is believed that this Verified Statement should suffice:

The Rejection Under 35 U.S.C. § 112, Second Paragraph

Certain claims were rejected because of the objected-to term that the structure “includes” certain features. This term appears only in claim 63 and claims 68-71.

As used in those claims, the term “includes” is used to describe features of the substituent, R⁴.

Respectfully, It is believed this term is not unclear. It simply specifies that the structure of R⁴, which is well defined in claim 39 from which these claims ultimately depend, has these specific substituents. Thus, these claims are more definite than claim 39 itself, which does not contain this term. The Office states that “it is unclear as to how the structure is linked to the molecule.” The claim is intended to cover the substituent R⁴ where R⁴ contains the substituent regardless of the position within R⁴. The claim is not unclear, it simply encompasses a multiplicity of positions.

The relevance of the cited RN 228552-28-1 and RN 562082-85-3 is unclear to applicants. The conclusion as to whether the claimed structures include the structures referred to can be determined readily – thus, the claims are not indefinite. The substituent in the position related to R⁴ in RN 228552-28-1 includes only the structure set forth in claim 68. Whether the compounds of claim 68 include the cited compound will depend on the remaining structural features of the molecule, which are clear. (In light of the amendment to claim 39, this structure is outside the scope

of claim 68 and all other claims.) With respect to compound RN 562082-85-3, the substituent corresponding to R⁴ includes only the substituent set forth in claim 70, and it does not matter whether the remainder of the molecule qualifies it as coming within the scope of the claims since the disclosure of this compound post-dates the application date herein by several years. However, this can easily be determined by comparing the structures.

As demonstrated, it is straightforward to determine whether the claims read on any particular structure in light of their wording; therefore they are sufficiently definite. This basis for rejection may therefore be withdrawn.

The Rejection Under 35 U.S.C. § 112, First Paragraph

This basis for rejection is said to have been maintained from the previous Office action. In reviewing the bases for rejection, the specific terms objected-to as improper scope were as follows:

“two R⁴ taken together form a bridge optionally containing a heteroatom”;

“CO or an isostere thereof”;

“CH, CH₂ or an isostere thereof” and

“Y is optionally substituted alkyl, optionally substituted aryl or optionally substituted aralkyl or two Y taken together may form an alkylene (2-3) bridge.”

The Office states that these terms were not found in the specification.

While applicants do not agree these terms are not supported, none of these terms now appear in the claims, except for the last-mentioned definition of Y.

As noted in the previous response, this description does appear in the correct application as filed. It is on page 3, at lines 16-17. Thus, this is clearly not new matter.

As the wording objected to in the claim indeed appears in the specification, applicants now look to the previous Office action to determine why it is believed, despite the *in haec verba* support in the specification, the Office might believe that somehow this scope is inappropriate. In the previous Office action, the Office states that “Those compounds embraced by the broad scope of the claims further evidenced (sic) that such compounds do not share the inventive utility as p-38 kinas(sic, kinase) inhibitor, see i.e. CA 131:676650.” The same criticism is set forth in the present Office action with respect to CA 139.

Applicants assume that the Office is taking the position that because similar compounds to those claimed are described as anti-thrombotics (CA 131) or as inhibitors of cell adhesion, molecular expression and inflammatory cytokine signal transduction (CA 139), this means that these similar compounds are not p38 kinase inhibitors.

There are two problems, at least, with this argument. First, it is not stated in either abstract that the compounds disclosed therein do not have utility as p38 kinase inhibitors. Actually, CA 139 states that the compounds are useful as inhibitors of inflammatory cytokine signal transduction, consistent with p38 inhibition. Second, even if the utilities described in these abstracts were totally different from those described in the present application, it does not follow that the activities disclosed herein do not exist, only that these abstracts did not disclose them.

In conclusion, respectfully, no adequate basis has been stated to lead to the conclusion that the definition of Y as set forth in the claims is lacking in support or is of inappropriate scope.

It will be left for later to point out that the compounds of CA 139 could not possibly anticipate the compounds of the present invention, since they post date the effective filing date herein by at least three years.

The Rejection Under 35 U.S.C. § 102(a)

Claims 39-40, 42, 45-46, 49 and 60 were rejected under 35 U.S.C. § 102(a) over “the anticipatory compounds such as RN 229553-27-0 but now anticipated also by RN 22852-28-1” (set forth in CA 131:67650).

First, applicants are unable to identify RN 229553-27-0. It does not appear in any of the documents supplied by the Office and an STN search for this registry number (enclosed) yielded no hits and the closest number 229553-27-9 is a nucleic acid sequence. Thus, applicants are unable to respond to this putative anticipation.

With respect to the compounds disclosed in CA 131:67650, such as 22852 (sic, 228552)-28-1, applicants have verified that the publication date of the journal article in which these compounds appeared is 5 April 1999. While applicants believe that they are entitled to the priority of grandparent application Serial No. 09/275,176 filed 24 March 1999 (now Patent 6,340,685) with respect to the claims as presently pending, in order to expedite prosecution, applicants have amended the claims to obviate this rejection.

In addition, applicants recognize claims 41, 44, 47-48, 50-53, 56-59 and 61-78 are free of this rejection. Claim 42 seems included in error, since X¹ is CO; claim 46 is included in error as it depends from claim 44.

The Provisional Rejection Under 35 U.S.C. § 102(f)

All claims were provisionally rejected as anticipated by CA 139. This basis for rejection is clearly in error. CA 139 is an abstract of a PCT publication WO 2003/057696, which claims a U.S. priority date of 7 January 2002. This is the earliest possible § 102(e) date that could ever be asserted; the present applicants are entitled at the very least to a priority date of 21 May 1999.

Accordingly, even if a U.S. patent were to issue, this document would not be citable under any section of the statute. The Office is reminded that even if an applicant associated with the publication summarized in CA 139 were to attempt to provoke interference, a *prima facie* case would have to be laid out by that applicant that he/she could prevail. Thus, a rejection under either 35 U.S.C. § 102(f) or 35 U.S.C. § 102(g) is improper and should be withdrawn.

Double Patenting

The withdrawal of the double patenting rejection is appreciated.

The Rejection Under 35 U.S.C. § 112, Second Paragraph, "Antecedent Basis"

It is assumed that this rejection is intended as asserting that the claimed subject matter may be "new matter" in light of the uncertainty as to the appropriate specification. The required Verified Statement enclosed should dispose of this rejection. The specification submitted with the response of 4 August 2003 is the correct and intended specification.

CONCLUSION

Applicants have amended the claims to expedite prosecution. While it is believed that applicants are entitled to a date earlier than that of the cited CA 131 document, the claims have been amended to avoid this disclosure. The only other cited document, CA 139 is not properly cited. It is believed that no outstanding basis for rejection remains and passage of the pending claims to issue is respectfully requested.

If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited and requested to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 219002028310.

Respectfully submitted,

Dated: February 23, 2004

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